

Appln No. 09/575,150  
Amdt. Dated October 7, 2005  
Response to Office Action of September 23, 2005

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## **REMARKS**

The Applicant thanks the Examiner for the final Official Action dated September 23, 2005.

### *Response to Arguments*

The Examiner stated that the Applicant's arguments filed on July 6, 2005 have been fully considered but are not persuasive. The Examiner then made several statements as to why the Applicant's arguments were not considered persuasive. Several of these statements are traversed below.

First, the Examiner stated that "Retrieval and manipulation of configuration parameters (i.e. standard operations) via printer's control panel is inherent in Goffinet." However, the Applicant's arguments have never denied such a position and have even acknowledged it. In the previous response the Applicants acknowledged that "...a manual setup using an operator panel directly at a particular laser printer is well known." But manipulation of configuration parameters (i.e., standard operations) via a printer control panel is not claimed. What is claimed is "...providing to a user, at the printer, the authorization identifier and the printer identifier... whereby the user of the network terminal proves physical access to the printer because the user obtained the printer identifier through physical access to the printer, thus increasing printer security." Neither Goffinet nor Eldridge teach obtaining an authorization identifier at a printer so as to prove physical access to the printer.

Second, the Examiner stated that "[t]he Goffinet prior art clearly states that both options, manual setup and remote setup, are implemented." The Examiner continued that "[t]herefore, the Goffinet prior art does not teach away from manual access to control a printer." But such dual options do teach away from the concept of proving physical access to a printer through the use of an authorization identifier. That is because if an authorization identifier can be obtained either remotely or through a manual setup procedure, then physical access to a printer is not required to obtain the identifier. Thus Goffinet does teach away from the limitations of the present claims concerning proving physical access to a printer.

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Third, the Examiner stated that "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference ... Rather, the test is what the combined teachings of the reference would have suggested to those of ordinary skill in the art." The Applicants have never suggested that Eldridge and Goffinet do not render the present invention obvious because these two references cannot be bodily incorporated together. Rather, the Applicants have simply maintained that neither Eldridge nor Goffinet disclose the concept of obtaining authentication information at a printer. Thus it is difficult to understand the Examiner's position that these references suggest such a concept to those of ordinary skill in the art. We respectfully remind the Examiner that he has the burden of establishing a *prima facie* case of obviousness. See MPEP 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness"). Further, MPEP 2142 states that "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." Here, the Examiner has not shown where either Eldridge or Goffinet teach or suggest providing to a user, at a printer, an authorization identifier so as to prove physical access to a printer. But that is a clear limitation of the present claims and therefore must be demonstrated to establish a *prima facie* case of obviousness.

Finally, the Examiner stated that "one cannot show nonobviousness by attacking references individually where rejections are based on combinations of references." However, here the Examiner has previously acknowledged that "Eldridge does not disclose obtaining authentication information at a printer." So the Applicants' have simply demonstrated that Goffinet also does not disclose or suggest obtaining authentication information at a printer. To establish obviousness the Examiner must show how either Eldridge or Goffinet, individually or together, either explicitly or implicitly, teaches or suggests obtaining authentication information at a printer to prove physical access to the printer. See MPEP 2143.01: "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

#### *Claim Rejections – 35 USC §103*

Claims 1-5, 7, 8 and 10-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) in view of Goffinet et al. (U.S. Patent No. 6,112,256). The rejection is respectfully traversed based on the arguments presented previously and in light of the comments provided above.


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As argued above, the Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicant:



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